

Express Mail No. EV 544917832 US

REMARKS

Claims 1-8 are currently pending and under consideration.

Reconsideration is respectfully requested of the rejection of claims 1-8 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "comprise" has been replaced with the term "defines" in claim 1. Further, contrary to the Examiner's assertions, the claims do define a meaningful chemical compound. The test for indefiniteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986). Claim 1 defines a metal alkoxide having a carbocyclic or heterocyclic skeleton containing 6 to 20 ring atoms. The only available heteroatom is oxygen. A person skilled in the art could certainly recognize whether or not a given compound falls within these claim parameters. In addition, the rings A, B, and C have been eliminated from claims 7 and 8 and replaced with taxane nucleus language. Applicant believes these amendments place the claims in order for allowance. See U.S. Serial No. 10/673,300 where similar amendments were made, leading to an allowance.

Reconsideration is requested of the rejection of claims 1-8 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,229,526, claims 1-28 of U.S. Patent No. 5,723,634 and claims 1-53 of U.S. Patent No. 6,069,260. In the interests of expediting prosecution and without conceding the propriety of the rejection, enclosed herewith is a Terminal Disclaimer in accordance with 37 CFR 1.130(b) and 37 CFR 1.321(c) to obviate the rejections. Accordingly, applicant respectfully requests the obviousness-type double patenting rejections be withdrawn.

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CONCLUSION

Applicant submits that the present application is now in a condition for allowance and requests allowance of the pending claims.

* A check in the amount of \$130.00 is enclosed for the Terminal Disclaimer. The Commissioner is hereby authorized to charge any underpayment and credit any overpayment of government fees to Deposit Account No. 19-1345.

Respectfully submitted,



Bradley S. Schammel, Reg. No. 54,667
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

BSS/vlm

*Enclosure